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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/659,967
Filing Date: September 11, 2003
Appellant(s): KRZYSIK ET AL.

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GROUP 1600

Christopher M. Goff
Reg. No. 41,785
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed July 13, 2007 appealing from the Office action mailed 30 November 2006.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings, which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

EP 0497144	CHUNG	08-1992
6,340,467	MORRISON	01-2002
4,925,653	GROLLIER et al.	05-1990
6,149,934	KRZYSIK et al.	11-2000
6,287,581	KRZYSIK et al.	09-2001

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

- Claims 1, 3, 5-13, 15-18, 21 and 27 rejected under 35 U.S.C. 103(a) as being unpatentable over EP 0497144 ('144) (Chung) in view of U.S. Pat. No. 6,340,467 ('467) (Morrison) and further in view of U.S. Pat. No. 4,925,653 ('653) (Grollier et al.).
- Claims 1, 3, 5-13, 15-23, 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over US 6,149,934 ('934) (Krzysik) view of EP 0497144 ('144) (Chung).
- Claims 1, 3, 5, 6, 10-13, 19-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over US 6,287,581 ('581) (Krzysik) in view of EP 0497144('144) (Chung).

A. Claims 1, 3, 5-13, 15-18, 21 and 27 rejected under 35 U.S.C. 103(a) as being unpatentable over EP 0497144 ('144) in view of U.S. Pat. No. 6,340,467 ('467) and further in view of U.S. Pat. No. 4,925,653 ('653).

'144 teach cosmetic compositions comprising (1) a particulate styrene-ethylene-propylene copolymer, (2) an emollient, and (3) a pigment or sun blocking agent (abstract). According to '144, the styrene-ethylene-propylene copolymer may be present in an amount between 0.5% to 90% by weight, the emollient may be present in an amount between 10% to 70% by weight, and the colorant particles may be present in an amount between 5% to 50% by weight (page 3, line 43 - page 4, line 11). As set forth in Example 2, the styrene-ethylene-propylene copolymer may be admixed with isododecane, the colorant may be iron oxide, the sunscreen may be Titanium Dioxide, the texture modifier may be talc, and the emollient may be isotetracoane or isododecane. Numerous other emollients, such as mineral oil, can also be used in the cosmetic composition advanced by '144 (page 2, line 55 - page 3, line 7). Additionally, based on the disclosure of '653, one would have the requisite motivation to add polyisobutylene to the cosmetic composition advanced by '144. According to '653, the addition of polyisobutylene to a skin care composition has the advantage of protecting human epidermis against UV radiation (column 1, lines 12-17).

Although '144 teaches that mixtures of emollients (such as mineral oil with a structurant - isoparaffins) can be used in the cosmetic composition, '144 does not specifically teach the same structurants as set forth in the instant claim set.

However, '467 teaches a composition comprising from about 5 - ~ 75% weight percent of an emollient, about 0.1 to 50% by weight percent of a wax, and up to 50% weight percent of a rheology enhancer (Claims 1 and 13; abstract; column 2, lines 46-54; column 2, lines 37-41; and column 4, lines 34-42). According to '467, mineral oil is a suitable emollient (column 2, lines 24-36), carnauba wax is a suitable structurant (column 4, lines 34-43), and a combination of mineral oil and styrene copolymers is a well-suited viscosity enhancer (column 3, lines 3-62 and column 4, lines 63-67). Because, according to '467, the addition of between 0.1 to 50% by weight of wax, such as carnauba wax or beeswax, can modulate the melting point and softening point of a cosmetic-based composition, one of ordinary skill in the art would have been motivated to add between 0.1 to 50% of carnauba wax or beeswax to the composition advanced by '144. Based on the teaching of '467, there is a reasonable expectation that the addition of a wax, such as carnauba wax or beeswax, would effectively modulate the melting point and softening point of a cosmetic-based composition, resulting in a composition suitable for dispersion to consumers. As such, it would have been obvious to one of ordinary skill in the art at the time the invention was made to add a suitable wax, such as carnauba wax or beeswax, to the cosmetic-based composition advanced by '144 in view of the teachings of '467.

(10) Response to Argument A:

Firstly, Appellant argues, "The '144 reference fails to disclose any of the specific rheology enhancers as required by claim 1. At best, the rheology enhancers disclosed in the '144 reference include isododecane in combination with styrene-ethylene-propylene diblock

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copolymers. However, in Applicant's claim 1, when the rheology enhancer includes isododecane, the isododecane is used in combination with triblock ethylene/propylene/styrene copolymers and butylene/ethylene/styrene copolymers. Nowhere in the '144 reference is the use of triblock ethylene/propylene/styrene copolymers or butylene/ethylene/styrene copolymers taught or suggested. The triblock copolymers as required in instant claim 1 provides improved functional properties to the topical ointment that cannot be achieved with the diblock copolymers of the '144 reference."

Appellant's arguments have been considered, but were not persuasive. The '144 reference teaches similar rheology enhancers as that being claimed by Applicant. The reference teaches a cosmetic composition having a first component comprising particulate styrene-ethylene-propylene copolymer, a second component comprising an emollient, which can be isododecane and a third component comprising either a colorant, sunblock agent or mixtures thereof (page 2, lines 21-28); Claim 1. Example 2, at page 4, for instance, also demonstrates a cosmetic composition whereby the styrene-ethylene-propylene copolymer may be admixed with isododecane. Applicant argues the use of the instant 'triblock' copolymers versus the prior art's 'diblock' copolymers. However, no patentable distinction has been observed, which accrues through the use of the instant triblock copolymers claimed. The prior art vividly recognizes and teaches a topical formulation as claimed that utilizes similar ingredients, such as the rheological enhancing agents, emollients, structurants and the like. The fact that Applicant attempts to distinguish over the prior art by employing a triblock copolymer combination versus the art's diblock copolymers fails to render a patentable distinction over the teachings of the art.

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., functional properties based on instant triblock copolymers) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). Thus, Appellant's arguments based on improved functional properties, which accrue from the instant triblock copolymers was not persuasive since Appellant's arguments do not establish the scope of claims being presented. The asserted functional properties argued by Appellant are not recited nor required in the instant claims. Moreover, the topical formulations of the '144 reference also provides for improved and beneficial results through the use of their styrene-ethylene-propylene copolymers used in combination with isododecane. Namely, the '144 reference teaches that the compositions offer desirable characteristics, such as leaving a smooth texture upon application to the skin and being easily spreadable, which are the same objectives desired by Appellant (see p. 2, lines 1-4).

Appellant argues, "The Morrison and Grollier et al. references fail to overcome the above shortcomings. Nowhere is it disclosed to use isododecane in combination with ethylene/propylene/styrene copolymers and butylene/ethylene/styrene copolymers in either Morrison or Grollier."

Appellant's arguments have been considered, but were not persuasive. Morrison ('467) was relied upon for resolving the deficiency of '144 by their teaching of the use of the instant selective structurants, such as carnauba wax or beeswax. '467 teaches the inclusion of waxes (carnauba wax; beeswax) in order to modulate the melting point and softening point of a

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cosmetic-based composition, and thus results in improved dispersion of the composition. Thus, Morrison, which was relied upon for the instant selective structurants, is sufficient for all that it teaches. Grollier et al. ('653) was relied upon for the teaching that rheological enhancing agents, such as polyisobutylene, are commonly used in the cosmetic art and are used for their protective functions for human epidermis against UV radiation. The secondary reference, therefore provides ample motivation to employ polyisobutylene, since polyisobutylene is taught to be a suitable rheology enhancing agent for use in the art.

Appellant argues, "The Office States that one skilled in the art would be motivated to combine the polyisobutylene of Grollier et al. with the '144 and Morrison references simply because Grollier et al. disclose the addition of polyisobutylene to a skin care composition has the advantage of protecting human epidermis against UV radiation. This generic statement is not sufficient motivation for one skilled in the art to combine references and arrive at Applicant's invention. Providing a sunblock agent to protect the skin from sunburn is merely an optional ingredient in the '144 reference. There is no motivation to use the polyisobutylene sunblock agent of Grollier over any other enormous number of sunblock agents described in the art."

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the secondary reference of Grollier et al., as delineated above, was relied

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upon solely for the teaching that rheological enhancing agents, such as polyisobutylene, are commonly used in the cosmetic art and are used for their protective functions for human epidermis against UV radiation. The secondary reference, therefore provides ample motivation to employ polyisobutylene, since polyisobutylene is taught to be a suitable rheology enhancing agent for use in the art. Examiner respectfully disagrees with Appellants who state that “the addition of polyisobutylene to a skin care composition has the advantage of protecting human epidermis against UV radiation” is a generic statement. Grollier amply provides motivation based on their explicit teaching of the use of polyisobutylene, which serves to increase the protection index of the sunscreen composition and protecting human epidermis against ultraviolet radiations (see column 1, lines 12-17 of ‘653). This is an explicit teaching of the benefits attributable to the use of polyisobutylene in the sunscreen compositions of ‘653 and not a ‘generic statement’ as argued by Appellant. Appellant’s argument that the “use of a sunblock agent is an optional component in the ‘144 reference and that this disclosure alone does not provide sufficient motivation” was not persuasive, since ‘optional’ is a positive suggestion, which cannot be ignored in the art. The ‘144 reference is entirely suggestive of the inclusion of sunblock, based on the term ‘optional’.

Appellant argues, “While polyisobutylene is disclosed in the Grollier et al. reference, the Grollier et al. reference fails to disclose the polyisobutylene in its’ composition in combination with a structurant being present in the composition in an amount of from about 20% by total weight to about 40% by total weight as required in Applicant’s claim 1.”

The Examiner was not persuaded by this argument. Appellants have not established any unexpected or superior results, attributable the claimed percentage of polyisobutylene.

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Moreover, the Examiner points out that generally, differences in concentration will not support the patentability of subject matter encompassed by the prior art unless there is evidence indicating such concentration is critical. “[W]here the general conditions of a claim are disclosed in the prior art, it is not inventive to discover the optimum or workable ranges by routine experimentation.” *In re Aller*, 220 F.2d 454, 456, 105 USPQ 233, 235 (CCPA 1955).

Appellant argues, “It appears that the office has used impermissible hindsight analysis and reconstruction when combining the ‘144, Morrison and Grollier et al. references.”

In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

* * * * *

B. Claims 1, 3, 5-13, 15-23, 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over US 6,149,934 ('934) view of EP 0497144 ('144).

'934 teach a composition comprising from about 5 - 95 weight percent of an emollient, about 5 - 95 weight percent of a wax, and about 0.1 - 25 weight percent of a viscosity enhancer (abstract and column 2, lines 10-37). According to '934, mineral oil is a suitable emollient

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(column 9, line 47) and beeswax is a suitable structurant (column 10, line 22). Like the instant claims 7-9, the viscosity of the composition advanced by '934 is between about 50 - 50,000 centipose (column 12, lines 42-53). The composition set forth by '934 can also comprise a variety of other chemical agents, such as antifoaming agents and fragrances (column 11, lines 24-60).

The composition advanced by '934 can also comprise a surfactant, such as sorbitan monooleate, and a hydrophilic skin care active, such as glycerin (column 11, line 16; column 11, lines 59-60; and column 9, lines 21-22). In another embodiment, the composition can include 20 - 75 weight percent of a particulate material, such as calcium carbonate (column 7, lines 3-17).

'934 does not specifically teach a rheology enhancer selected from the list set forth in the instant Claims 1 and 23.

However, '144 teaches the advantages of using rheology enhancers comprising styrene-ethylene-propylene copolymers admixed with isododecane in a cosmetic compositions (Example 2 and page 2, lines 33-26). According to '144, cosmetic compositions comprising styrene-ethylene-propylene copolymers are effective substrates suitable for transfer and spreading on skin in a smooth fashion (page 2, lines 33-36). Moreover, another advantage of using styrene-ethylene-propylene copolymers in a cosmetic composition is that they render said composition relatively transfer proof, meaning that said composition will not flake-off the skin after application (page 2, line 33-36). Since the addition of styrene-ethylene-propylene copolymers to a cosmetic composition render said composition-relatively transferproof, meaning that said composition will not flake-off the skin after application, one of ordinary skill in the art would have been motivated to add styrene-ethylene-propylene copolymers admixed with Isododecane

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to the ointment composition proposed by '934. Based on the teachings of '144, there is a reasonable expectation that a topical ointment comprising styrene-ethylene-propylene copolymers would result in a composition that is relatively transferproof, meaning that said composition will not flake-off the skin after application. As such, it would have been obvious to one of ordinary skill in the art at the time the invention was made to add styrene-ethylene-propylene copolymers admixed with isododecane to the cosmetic composition advanced by '934 in view of the teachings of '144.

(10) Response to Argument B:

Appellant argues, "As noted by the Office, the '934 reference fails to teach or suggest the specific rheology enhancers as required by Applicant's claim 1. The '144 reference fails to overcome the above shortcomings, namely the '144 reference fails to teach or suggest the rheology enhancers as required by Applicant's claim 1. While the '144 reference discloses the use of isododecane in combination with *diblock* styrene-ethylene-propylene copolymers, nowhere in the '144 reference is it taught to combine isododecane with *triblock* ethylene/propylene/styrene copolymers and butylene/ethylene/styrene copolymers as required by Applicant's claim 1."

These arguments were unpersuasive. It is noted that the '144 reference teaches the use of isododecane in combination with diblock styrene-ethylene-propylene copolymers, whereas Applicants combine isododecane with triblock ethylene/propylene/styrene copolymers and butylene/ethylene/styrene copolymers. However, it remains the position of the Examiner that Appellants have not sufficiently set forth any patentable distinction that accrues from the instant

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triblock copolymers claimed. The '144 reference teaches a cosmetic composition that employs essentially similar components as that being claimed by Appellant. The prior art clearly recognizes and teaches a topical formulation as claimed that utilizes similar ingredients, such as the rheological enhancing agents, emollients, structurants and the like. The prior art teaches that beneficial results are attained, such as the compositions leaving a smooth texture upon application to the skin and being easily spreadable, which are the same objectives desired by Appellant.

Appellant argues, "A close reading of the '934 reference actually teaches away from using the styrene-ethylene-propylene copolymers of '144 in the '934 lotion. As disclosed in the '934 reference, it is desirable that the ointment, as with the ointment of the instant invention, is transferable from an absorbent article such as a diaper to the skin to provide improved skin health. The '144 reference is disclosed as providing a *transfer proof* composition. As such, a transfer proof composition, such as provided in the '144 reference, would not be desirable for use in the formulation of the '934 reference (or in the ointment of the instant invention)."

This argument was not deemed persuasive. Appellant's argument that the '934 reference teaches an ointment that is transferable and thus teaches away from the '144 reference's teaching of a composition that is transfer proof was not persuasive since the fact that a reference may possibly teach away from a certain ingredient as a result of a particular property (transfer of ointment), does not deter one of ordinary skill in the art from using that particular ingredient. In this instance, the instant claims, which are drawn to a composition, are completely silent with regards to any preferred properties attributable to the triblock copolymers, such as ease of transferring on the skin to provide improved skin health. Thus, Appellant's arguments are not

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consistent with the scope of claims being presented. The cosmetic compositions comprising styrene-ethylene-propylene copolymers taught by '144 are suitable for transfer and spreading on skin in a smooth fashion (page 2, lines 33-36). Furthermore, the prior art teaches the use of the same components, (i.e., rheology enhancers) as that claimed by Appellant. Hence, it is expected that the same beneficial properties exhibited by the rheology enhancers would be imparted to the skin of the user.

* * * * *

C: Claims 1, 3, 5, 6, 10-13, 19-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over US 6,287,581 ('581) in view of EP 0497144('144).

'581 disclose a composition comprising 5 - 95 weight percent of emollients, 5 - 95 percent wax, a structurant, 1 - 25 weight percent of a viscosity enhancer, humectants, and 1 - 20 weight percent of a surfactant (abstract, column 3, lines 32-39, column 5, lines 18-32, and Claim 1). Specific components used in the invention advanced by '581 include: montan wax, a well known structurant (columns 5, line 13); canola oil, a suitable emollient (column 4, line 47); ethylene/vinylacetate copolymers, a viscosity enhancer (column 5, lines 16-17); sorbitan monooleate, a surfactant having an HLB in the range of 3 to 6 (column 5, lines 1-2, column 7, lines 4-15); glycerin a hydrophilic skin care active (column 5, line 7). The composition set forth by '581 can also comprise a variety of other chemical agents, such as antifoaming agents and fragrances (column 12, lines 11-44).

'581 does not specifically teach a rheology enhancer selected from the list set forth in the instant Claims 1 and 23.

However, '144 teaches the advantages of using rheology enhancers comprising styrene-ethylene-propylene copolymers admixed with Isododecane in a cosmetic compositions (Example 2 and page 2, lines 33-26).

According to '144, cosmetic compositions comprising styrene-ethylene-propylene copolymers are effective substrates suitable for transfer and spreading on skin in a smooth fashion (page 2, lines 33-36). Moreover, another advantage of using styrene-ethylene-propylene copolymers in a cosmetic composition is that they render said composition relatively transferproof, meaning that said composition will not flake-off the skin after application (page 2, line 33-36). Since the addition of styrene-ethylene-propylene copolymers to a cosmetic composition render said composition relatively transferproof, meaning that said composition will not flake-off the skin after application, one of ordinary skill in the art would have been motivated to add styrene-ethylene-propylene copolymers admixed with Isododecane to the ointment composition proposed by '581. Based on the teachings of '144, there is a reasonable expectation that a topical ointment comprising styrene-ethylene-propylene copolymers would result in a composition that is relatively transferproof, meaning that said composition will not flake-off the skin after application. As such, it would have been obvious to one of ordinary skill in the art at the time the invention was made to add styrene-ethylene-propylene copolymers admixed with Isododecane to the cosmetic composition advanced by '581 in view of the teachings of '144.

(10) Response to Argument C:

Appellant argues, "As noted by the Office, the '581 reference fails to teach or suggest the specific rheology enhancers as required by Applicant's claim 1. The '144 reference fails to overcome the above shortcomings, namely the '144 reference fails to teach or suggest the rheology enhancers as required by Applicant's claim 1."

The Examiner was not persuaded by this argument. The prior art teaches similar copolymer combinations of rheology enhancing agents that would also impart effective results as that desired by Appellant's copolymer combinations. The use of Appellant's triblock copolymers does not patentably distinguish over the diblock copolymers disclosed by the '144 reference. Appellants have not sufficiently demonstrated how their formulation would provide for unexpected or superior results over that of the teachings of the art of record. The prior art establishes cosmetic formulations comprised of similar components that would yield improved and effective results. No significant patentable distinction has been observed in Applicant's use of the ethylene/propylene/styrene copolymers and butylene/ethylene/styrene copolymers when used with isododecane. The '144 reference teaches that their compositions offer desirable characteristics, such as leaving a smooth texture upon application to the skin and being easily spreadable, which are the same objectives desired by Appellant.

Appellant argues, "The lotion of '581 is designed to transfer from an absorbent article to the skin to improve skin health, whereas the styrene-ethylene-propylene copolymers of the '144 reference cause the composition to be transfer proof."

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This argument was not persuasive. The Examiner points out that the claims, as presently recited, are silent with regards to the particular properties (easy transfer of ointment) argued by Appellant. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

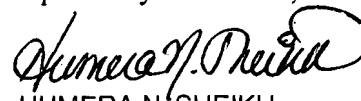
Given the explicit teachings of the art, the instant invention, when taken as a whole, would have been *prima facie* obvious to one of ordinary skill in the art at the time the invention was made.

(11) Related Proceeding(s) Appendix

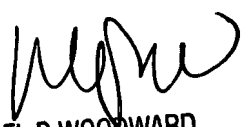
No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,


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